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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TERRY WAYNE HORNBAKER, MICHAEL A. PADGEN,
RAELYNN A. SINK, and SETH AARON HOROWITZ

Appeal 2016-001794
Application 12/948,458¹
Technology Center 3600

Before CARLA M. KRIVAK, DEBRA K. STEPHENS, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3–10, and 23–35, which are all of the claims pending in the application. App. Br. 6. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to allocating scarce resources to customers “according to score values associated with each customer.” Spec. Abstract; *see also* Spec. Fig. 7. Claim 1 is illustrative and reproduced below:

¹ According to Appellants, the real party in interest is Accenture Global Services Ltd. App. Br. 4.

1. A computer-implemented method, comprising:
 - identifying a group of individuals that includes a particular individual and one or more other individuals associated with the particular individual;
 - retrieving profile information associated with the particular individual;
 - retrieving booking information associated with the particular individual;
 - identifying at least one of an event and an event class, from multiple events and event classes, associated with the particular individual;
 - selecting, by at least one computer processor, at least one of a scoring rule and a set of scoring rules, from multiple scoring rules and multiple sets of scoring rules, based on at least one of the identified event and the identified event class, the scoring rule and the set of scoring rules associated with each event or event class differing from the scoring rule and the set of scoring rules associated with remaining possible events and event classes;
 - generating, by the at least one computer processor, a score value associated with the particular individual, the score value being generated based on at least one of the profile information and the booking information and according to at least one of the selected scoring rule and the selected set of scoring rules;
 - identifying a highest score value associated with the group of individuals;
 - associating the highest score value as the score value for the particular individual;
 - allocating one or more resources to the particular individual based on the score value associated with the particular individual; and
 - updating the booking information associated with the particular individual to indicate the allocation of the one or more resources to the particular individual.

Rejection

Claims 1, 3–10, and 23–35 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 2–3.

ISSUE

Did the Examiner err in concluding the claims are directed to ineligible subject matter?

ANALYSIS

Section 101 defines patentable subject matter: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court, however, has “long held that this provision contains an important implicit exception” that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quotation omitted). “Issues of patent-eligible subject matter are questions of law and are reviewed without deference.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1369 (Fed. Cir. 2011). To determine patentable subject matter, the Supreme Court has set forth a two-part test. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014).

Step One

“First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice*, 134 S. Ct. at 2355. A court must be cognizant that “all inventions at some level embody, use, reflect, rest upon, or apply laws

of nature, natural phenomena, or abstract ideas” (*Mayo*, 566 U.S. at 71), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, “the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

In the present application, the Examiner concludes “[t]he claims are directed to the abstract idea of generating score values” and they are “drawn to the recognized judicial exception of collecting data, recognizing certain data within the collected data set, and storing that recognized data” as well as “using rules to identify options.” Ans. 2. Appellants argue “this characterization of the claims is overbroad” and ignores the specific limitations in the claims that “provide a concrete, tangible result – allocation of resources to the particular individual and updating booking information associated with the particular individual to indicate the allocation.” App. Br. 12–13.

We are not persuaded by Appellants’ arguments. “Distinguishing between claims that recite a patent-eligible invention and claims that add too little to a patent-ineligible abstract concept can be difficult, as the line separating the two is not always clear.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1255 (Fed. Cir. 2014). Often, “there is considerable overlap between step one and step two.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). “[T]he decisional

mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen.” *Id.*

Although non-precedential, we find persuasive the Examiner’s analogy of the case to *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 F. App’x 950 (Fed. Cir. 2014) (unpublished). In that case, the claims recited “providing patient information to a computing device” and “generating . . . a ranked listing of available therapeutic treatment regimens for said patient.” *Id.* at 951–52. This was accomplished using “a first knowledge base comprising . . . therapeutic treatment regimens” and “a second knowledge base comprising . . . expert rules for evaluating and selecting a therapeutic treatment regimen.” *Id.* The Federal Circuit concluded this was “a process defined simply as using a computer to perform a series of mental steps that people, aware of each step, can and regularly do perform in their heads.” *Id.* at 954 (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“Such a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”)).

The same is true here where a generic processor is used to apply scoring rules to determine which individual to book first. “[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016). For example, if a restaurant table (“a resource”) becomes available (“an event”), the restaurant hostess identifies the parties on the waitlist (“a group of individuals”); ranks each waiting party (“score value” from a “scoring rule”) by considering, for

example, the number of people in each party (“booking information”) and whether anyone in each party is a VIP at the restaurant (“profile information”); determines the party to seat first based on that information (“allocating” the table based on the “score values”); and crosses that party off the waitlist (“updating the booking information”). Thus, just as in *SmartGene*, beyond a generic processor, the claims are directed to a series of mental steps that people can and regularly do perform in their heads or with pen and paper (e.g., the waitlist for a restaurant).

We further agree with the Examiner that “limiting an abstract idea to a specific field of use or adding token post-solution activity does not make an abstract idea patentable.” Ans. 3; *Alice*, 134 S. Ct. at 2358.

Thus, Appellants have not persuaded us that the Examiner erred in determining the claims were directed to an abstract idea.

Step Two

In the second step, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78). The Supreme Court has “described step two of this analysis as a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *Id.* (quotation omitted).

Appellants contend the claims “do not preempt substantially all applications of the alleged abstract idea” because the Examiner indicated the claims were novel over the prior art and therefore “the prior art could be practiced without infringing” the claims of the present application. App. Br.

14. Yet this improperly conflates the requirements for eligible subject matter (§ 101) with the independent requirements of novelty (§ 102) and non-obviousness (§ 103). “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981). “[U]nder the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016). We therefore are not persuaded by Appellants’ argument for step two. Instead, we agree with the Examiner that beyond simple mental or business steps, the claims recite only “generic computer functions.” Ans. 2–3.

Accordingly, we sustain the Examiner’s rejection of claim 1, and claims 3–10 and 23–35, which Appellants argue are patentable for similar reasons. *See* App. Br. 12–14; 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

For the reasons above, we affirm the Examiner’s decision rejecting claims 1, 3–10, and 23–35.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED